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IN THE
SUPREME COURT OF THE UNITED STATES.

No. **618.**

OCTOBER TERM, 1913.

STREET & SMITH, a Copartnership,
Composed of ORMOND G. SMITH,
GEORGE C. SMITH, and CORA E.
GOULD,

PETITIONERS,

vs.

THE ATLAS MANUFACTURING COM-
PANY and ORLIN T. CRAWFORD,
RESPONDENTS.

In Equity.

United Supreme Court, U. S.
FILED.

JUN 30 1913

JAMES H. MCKENNEY

CLERK

PETITION FOR CERTIORARI AND BRIEF
IN SUPPORT THEREOF.

HUGH K. WAGNER,

Solicitor for Petitioners,

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HUGH K. WAGNER,
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OF COUNSEL FOR PETITIONERS.

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*To the Honorable the Chief Justice and Associate Jus-
tices of the Supreme Court of the United States:*

Now come Street & Smith, a copartnership composed of Ormond G. Smith, George C. Smith, and Cora E. Gould, the petitioners in the above-entitled cause, and pray that this Honorable Court will issue its writ of *certiorari* directed to the United States Circuit Court of Appeals for the Eighth Circuit, requiring that the record of this cause in said court and its decree be

certified to this court for the determination of said cause by this Honorable Court and, thereupon, that this court will proceed to correct the errors complained of herein, by reversing said decree and giving to your petitioners such other and further relief as the nature of the case may require and as this court may deem meet and proper. For grounds of said petition, your petitioners respectfully state the following reasons:

I.

An appeal to this court was allowed by Mr. Justice Van Deyanter on May 26, 1913, the same operating as a *supersedeas*. This appeal was allowed in view of Sections 128 and 241 of "The Judicial Code", which was enacted March 3, 1911—upward of a year later than the decision of this court in *Hutchinson, Pierce & Company v. Loewy*, 217 U. S., 457; 54 L. Ed., 838. The issuance of this writ of *certiorari* will eliminate any question as to the jurisdiction of this court. A registered trade mark (Record, page 11) is one of the grounds of jurisdiction of the lower court, and the new Judicial Code does not make such cases final in the Circuit Courts of Appeals (section 128). Cases based on registered trade marks are, of course, not cases arising "under the copyright laws", and "The Judicial Code" is the latest expression of the intention of Congress as to the cases in which the decisions of the several Circuit Courts of Appeals shall be final, and, therefore, supersedes the decision of this court in *Hutchinson v. Loewy*, *supra*, based upon this court's interpretation of prior legislative enactments. The Act of March 3, 1891, made the decisions of the Circuit Courts of Appeals final in patent cases. "The Judicial Code" adds copyright cases to the list of

those that shall be final in the Circuit Courts of Appeals, but does not mention registered trade-mark cases. Following, as the enactment of "The Judicial Code" does, the decision of this court in *Hutchinson v. Loewy*, *supra*, there is a clear implication that registered trade-mark cases are not final in the Circuit Courts of Appeals.

However, it will eliminate the discussion of this question of jurisdiction if the writ of *certiorari* petitioned for hereby is granted.

II.

This case presents a question of law that has never before been presented to any court, and the four judges in the courts below who have passed on it in this litigation have been equally divided in opinion. Judge Trieber, of Little Rock, Arkansas, who heard the case in the District Court, granted a preliminary injunction sustaining petitioners' contentions. The defendants in the court below appealed to the United States Circuit Court of Appeals for the Eighth Circuit, at the hearing in which Judges Hook, Smith, and Van Valkenburgh sat. Judges Smith and Van Valkenburgh concurred in an opinion written by Judge Van Valkenburgh (Record, page 47) reversing the lower court and ordering the dismissal of the bill of complaint (Record, page 55).

The dissenting opinion of Judge Hook is an exact and, we think, correct epitome of the whole case, and reads as follows (Record, page 55):

"My objection to the above conclusion can be expressed in a sentence. The defendants are engaged in appropriating the fruits of complainants' current endeavors, and are deceiving the public."

III.

The question of law involved in this case and which, as above stated, is in this litigation presented for the first time for adjudication by any court is whether or not, when a publisher has a trade-mark for a periodical publication devoted to fiction or for any other form of publication, a manufacturer of films for motion pictures can legally feature that trade-mark upon, and in connection with, films for moving pictures.

This question will necessarily recur frequently in this "moving picture age", and its authoritative disposition by this court in this first case of the kind that has been submitted to the courts will be productive of much good in preventing other litigation involving the same question.

Since March, 1885 (Record, page 2), your petitioners and their predecessors in business have used the name "NICK CARTER" as a trade-mark and trade-name for a weekly publication devoted to detective stories and (Record, page 20) "information concerning civic, metropolitan, geographic, financial, business, and other matters" and "the news of all nations". Under date of April 19, 1910, they registered the name "NICK CARTER" in the United States Patent Office as a trade-mark "for a weekly periodical devoted to fiction, in Class 38, prints and publications", under registry No. 77,581 (Record, page 13). The bill of complaint is drawn on the threefold aspect of a common-law trade-mark in the words "NICK CARTER" and the registered trade-mark "NICK CARTER" and unfair competition in business. Petitioners are citizens of New York, and respondents are citizens of Missouri.

Respondents manufactured and advertised a moving-picture film that was shown to both the District Court

and the United States Circuit Court of Appeals below bearing the words "NICK CARTER, the Great American Detective", and further advertised the same in the Cincinnati publication called "The Billboard" (Record, page 4).

The reason why respondents (defendants) chose to associate the name of "NICK CARTER" with their motion-picture detective stories is evidenced by the statements contained in respondents' (defendants') own advertisements, from which we quote the following expressions: "Nicholas Carter is undoubtedly the most celebrated fictional character ever introduced to youthful American readers. Every American boy has read of 'Nick' Carter's adventures — 'Nick' Carter never dies—the book introduced him—the drama set all Paris wild with enthusiasm, and now we 'film' this intrepid American sleuth in three reels of sensational escapades. * * * State Rights Men's Greatest Opportunity!! You'll Have to Hurry, 'Nick Carter' will positively get the money" (Record, p. 13). This follows respondents' (defendants') selfadulation because of their business acumen in seeing a chance to make money easily and quickly in their expression in the same advertisement (Record, p. 13): "We Have Struck Oil B'Gosh!!!". Another advertisement of respondents (defendants) advertises the advantage of the "NICK CARTER" name to them and their prospective state agents in the following language: "The Best Quick-Money Film Feature in the World. It is all ready and you'll have to act quickly! The sensational and thrilling adventures of 'NICK' CARTER The Great American Detective. We have just finished what all the managers in the near-by vicinity of St. Louis consider one of the greatest money-making pictures ever re-

leased since the discovery of motion photography. The title is 'Nick Carter', the great detective, a name which is known to about 99% of the population of this country. He is seen in this picture solving the \$100,000.00 Jewel Mystery. Three Reels—2700 Feet. A chance of a lifetime. State Right Men. Every man, woman, and child is a booster for 'Nick' Carter!" (Record, p. 14).

STREET & SMITH,

By ORMOND G. SMITH,

A Member of the Firm.

HUGH K. WAGNER,

Solicitor for Petitioners.

HUGH K. WAGNER,

LEONARD J. LANGBEIN,

Of Counsel for Petitioners.

UNITED STATES OF AMERICA
SOUTHERN DISTRICT OF NEW YORK
STATE OF NEW YORK
COUNTY OF NEW YORK. } ss.

Ormond G. Smith, being duly sworn, on his oath states that he is a member of the firm of Street & Smith, the petitioners in the above-entitled cause; that he has read the foregoing petition for writ of *certiorari*, and knows the contents of same; and that the facts therein stated are true, as he verily believes.

ORMOND G. SMITH,

Sworn to and subscribed before me this 23rd day of June, 1913.

CHARLES W. OSTERTAG,

[SEAL]

Notary Public.

New York County, No. 2879.

We hereby certify that we are of counsel for the petitioners in this cause and that in our judgment the above petition for *certiorari* is well founded in point of law and fact and ought to be granted.

HUGH K. WAGNER,

LEONARD J. LANGBEIN,

Of Counsel for Petitioners.



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BRIEF FOR PETITIONERS.

Complainants in the case at bar contend that, within the principle of numerous trade-mark as well as unfair competition cases a detective story displayed, sold, or advertised under the name "Nick Carter" or with which that name is prominently associated infringes the undisputed trade-mark and trade-name of complainants, "Nick Carter", for detective stories published in letter-press form as books, pamphlets, periodicals, weeklies, serials, etc., whether defendants' publications be in the form of books, weeklies, or moving-picture films.

THE COMMERCIAL PROPERTY IN BOOKS, PERIODICALS, WRITINGS, AND THE LIKE IS PROTECTED BY TRADE-MARKS AND THE RULES OF LAW AGAINST UNFAIR COMPETITION IN BUSINESS.

In this case we have to consider books, not from the literary standpoint, but as merchandise; not as literature, but as articles of commerce. As such, they are entitled to be marked with a trade-mark just as much as any other objects vendible in the market. There may be a trade-mark for books or magazines or periodicals or newspapers just as well as for footwear, furniture, or automobile tires.

The trade-mark for a book or other form of publication is that of the publisher, and not of the author. Of course, if the author were, also, the publisher, the trade-mark would be his notwithstanding his dual capacity, but his trade-mark right would be his by virtue of his capacity as publisher, and not because of his authorship. The publisher of a book or periodical is its maker in the same sense that other articles of commerce are manufactured, and he trades in his publications, *i. e.*, his manufactured books or periodicals, in the same way that merchants deal in other marketable products.

Numerous cases have been decided by the courts that recognize that the principles of trade-mark law and the law forbidding unfair competition in business apply to books, magazines, newspapers, and the like, and, from among these, we cite the following:

Relating to Books.

Oxford University v. Wilmore-Andrews Publishing Co., 101 Fed., 443 (Oxford Bible case).

- G. & C. Merriam Co. v. Straus, 136 Fed., 477, 479
(a Webster's Dictionary case).
Ogilvie v. G. & C. Merriam Co., 149 Fed., 858 (a
Webster's Dictionary case).
Merriam v. Holloway Publishing Co., 43 Fed., 450
(one of the Webster's Dictionary cases).
Merriam v. Texas Siftings Publishing Co., 49 Fed.,
944 (another Webster's Dictionary case).
Merriam v. Famous Shoe & Clothing Co., 47 Fed.,
411 (another Webster's Dictionary case).
Social Register Association v. Howard, 60 Fed.,
270 (a case involving a directory of selected
names).
Harper & Brothers v. Laro, 103 Fed., 203; 93 Fed.,
989; 86 Fed., 481; 30 C. C. A., 376; 84 Fed., 222,
224 (involving a book describing Nansen's
arctic expedition).
Kipling v. G. P. Putnam's Sons, 120 Fed., 631.
Estes v. Worthington, 31 Fed., 154; 24 Blatchf.,
371 (a "Chatterbox" case).
Estes v. Leslie, 27 Fed., 22; 23 Blatchf., 476 (an-
other "Chatterbox" case).
Estes v. Williams, 21 Fed., 189; 22 Blatchf., 364
(another "Chatterbox" case).
Browne on Trade-Marks, see 116 and cases there
cited; also, see secs. 14-15 of same work.

Relating to Magazines and Other Periodicals.

- Gannett v. Rupert, 127 Fed., 962 (C. C. A., Second
Circuit); 62 C. C. A., 594; 127 Fed., 962.
New York Herald Co. v. Star Co., 146 Fed., 204.
Matsell v. Flanagan, 2 Abb. Pr. (N. S.), 459.
Forney v. "Engineering News" Publishing Co., 10
N. Y. Supp., 814.
Bradbury v. Beeton, 21 L. T. (N. S.), 323.
Osgood v. Allen, 1 Holmes, 185; Fed. Case No.
10,603.
Stokes v. Allen, 56 Hun., 526.

- Longman v. Tripp, 2 Bos. & P. W., 67.
Ex parte Foss, 2 DeG. & J., 230.
Kelley v. Hutton, L. R. 3 Ch., 703, 708.
Investor Publishing Company of Mass. v. Dobinson, 82 Fed., 56; 72 Fed., 603.
Snowden v. Noah, Hopk. Ch. (N. Y.), 351.
Stephens v. De Conto, 7 Rob. (N. Y.), 343, 348.
Dayton v. Wilkes, 17 How. Pr. (N. Y.), 510.
Joseph Dixon Crucible Co. v. Guggenheim, 2 Brewst. (Pa.), 321, 339.
American Grocer Pub. Assn. v. Grocer Pub. Co., 25 Hun (N. Y.), 398.
Clement v. Maddick, 5 Jur. (N. S.), 592.
Ingram v. Stiff, 5 Jur. (N. S.), 947.
Bell v. Lock, 8 Paige, 75.
Duniway Publishing Co. v. Northwest Printing, etc., Co., 11 Oregon, 322.
Browne on Trade-Marks (2d ed.), sees. 546-552 and cases there cited.
Robertson v. Berry, 50 Md., 591; Price & Stuart's Trade-Mark Cases, p. 153.
Hogg v. Kirby, 8 Ves., 215; Seb., 10.
Longman v. Winchester, 16 Ves., 269; Seb., 15.
Edmonds & Benbow, Seton (3d ed.), 905.
Re Edinburgh Correspondent Newspaper, 1 Ct. of Sess. Cas. 1st ser. (new ed.), 407 n.; Cox's "Manual of Trade-Mark Cases", No. 34.
Spottiswoode v. Clark, 10 Jurist, 1043.

Annual Books.

- Social Register Association v. Howard, 60 Fed., 270.
The "Chatterbox" cases: *Estes v. Worthington*, 31 Fed., 154; 24 Blatchf., 371; *Estes v. Leslie*, 27 Fed., 22; 23 Blatchf., 476; *Estes v. Williams*, 21 Fed., 189; 22 Blatchf., 364.

Good Will of a Periodical.

The Supreme Court of the United States has distinctly stated that the good-will of a newspaper is protectible, saying in the case of *Metropolitan Nat. Bank v. St. Louis Dispatch Co.*, 149 U. S., 436, 446; 37 L. Ed., 799, 802, per Mr. Chief Justice Fuller, that:

"Mr. Justice Story defined good-will to be 'the advantage or benefit, which is acquired by an establishment, beyond the mere value of the capital, stocks, funds or property employed therein, in consequence of the general public patronage and encouragement which it receives from constant or habitual customers, on account of its local position, or common celebrity, or reputation for skill or affluence, or punctuality, or from other accidental circumstances or necessity, or even from ancient partialities or prejudices.' Story, *Partnership*, sec. 99. As applied to a newspaper, the good-will usually attaches to its name rather than to the place of publication. The probability of the title continuing to attract custom in the way of circulation and advertising patronage, gives a value which may be protected and disposed of and constitutes property."

To the same effect see

Dayton v. Wilkes, 17 How. Pr., 510.

Gannert v. Rupert (C. C. A. 2d Cir.), 62 C. C. A., 594; 127 Fed., 962, 963.

Browne on Trade-Marks (secs. 116-117) says:

"Can printed books be protected by trade-marks? Yes, as mere merchandise; no, as literary productions. They are articles of manufacture, and may bear a particular mark to designate their author or the merchant who sells them. * * *

But it must be borne in mind that it is as merchandise merely, and not as intellectual creations, that books are protected by the mark of commerce."

In the case of *G. & C. Merriam Co. v. Straus*, 136 Fed., 477, 479, Judge Wallace said:

"There may be a commercial property in books as well as a literary property, and when a publisher has imparted to his books peculiar characteristics which enable the public to distinguish them from other books embodying the same literary property, and to recognize them as his particular product, there is no reason why the principles which interdict unfair competition in trade should not afford him protection against the copying of the characteristics by rivals."

In the case of *Dixon Crucible Co. v. Guggenheim*, 2 Brewst., 321, *Cox's Am. Tr. Mk. Cases*, 559, 577, the Philadelphia Court of Common Pleas, by Judge Paxson, said:

"The name of a newspaper is a trade-mark—as much so as a label stamped upon a bale of muslin."

The Court of Appeals of Maryland, in the case of *Robertson v. Berry*, 50 Md., 591, *Price & Stenart's Trade-Mark Cases*, p. 153, said:

"A publisher or author has either in the title of his work or in the application of his name to the work, or in the particular marks which designate it, a species of property similar to that which a trader has in his trade-mark, and may like a trader claim the protection of a court of equity against such use or imitation of the name, marks,

or designations as is likely in the opinion of the court to be a cause of damage to him in respect of that property (Kerr on Injunctions, 478; Browne on the Law of Trade-Marks, sec. 553).''

The case of *Ogilvie v. G. & C. Merriam Co.*, 149 Fed., 858, is one in which Judge Colt applied to Webster's Dictionaries the principles of the law of unfair trade, and this decision was affirmed by the United States Circuit Court of Appeals for the First Circuit in 159 Fed., 638.

The following statement is quoted from Bowker on Copyright (pages 262, 263):

"In 1887 the Harper house, as publishers of the *Franklin Square Library*, obtained from the U. S. Circuit Court, through Judge Waite, an injunction against the Franklin Square Library Company for violation of their trade-mark rights in the name."

In the case of *Matsell v. Flanagan*, 2 Abb. Pr. N. S., 459, Cox's American Tr. Mk. Cases, 367, the court said:

"The enforcement of the doctrine that trade-marks shall not be simulated does not depend entirely upon the alleged invasion of individual rights, but as well upon the broad principle that the public are entitled to protection from the use of previously-appropriated names or symbols, in such manner as may deceive them, by inducing or leading to the purchase of one thing for another. It is not necessary, therefore, to the exercise of judicial powers that the plaintiff's should have any other property in the name used than that possessed by any other person. * * * There is neither honesty nor honorable competition in

adopting, for a similar purpose, a name used by another, if it be employed in such a manner that the public may be imposed upon, and such a result must follow if the simulation be so successful that one article or creation is purchased or accepted for another. The adjudged cases, both in England and in this country, bearing upon this subject, establish these principles. The following are cited for illustration: Croft v. Day, 7 Beav., 84; Hogg v. Kirby, 8 Ves., 214; Knott v. Morgan, 2 Keen, 219; Crawshay v. Thompson, 4 Man. & Gr., 357; Brooklyn White Lead Co. v. Masury, 25 Barb., 416; Lemoine v. Ganton, 2 E. D. Smith, 343; Amoskeag Manufacturing Company v. Spear, 2 Sand. S. C., 599; Corwin v. Daly, 7 Bos., 222; Partridge v. Menck, 2 Sand. Ch. R., 622; Coates v. Holbrook, 2 Sand. Ch. R., 586; Williams v. Johnson, 2 Bos., 1. *A newspaper establishment is not excluded from the advantage of these rules. It is a species of property, and the rights which appertain to it, so far as they are private and exclusive, are entitled to the protection of the laws. Snowden v. Noah, 1 Hapk., 351; Bell v. Locke, 8 Paige, 75. The title of a newspaper may be a purely original one, and the proprietor for that reason entitled to its exclusive use. He may create a word, or combination of words, for the particular designation of his paper, and in that way acquire the exclusive right to the use of the name employed. He may combine, as the plaintiffs have, well-known English words in common use, to designate his paper, and its contents may, in many respects, be multiplied by publications in other prints, but the paper will, nevertheless, be original in some, if not in many, respects. The individualities of editorial life are as rarely duplicated as those displayed in other pursuits; and the intellectual vigor distinguishing the character and value of*

different prints, though equal in power, will be essentially different in thought, in the principles announced and advocated, and in the reasoning by which the same theories are advanced and sought to be established. *A newspaper in its commanding elements is the result of mental labor, and should be protected to the same extent, at least in the use of symbols, names, and marks, as any other property.* It may be that as it changes from day to day, or week to week, and is more or less recreated by each publication, becoming, as it were, the mirror as well as the chronicler of the times, it is better entitled to such protection by reason of its multiplied originality. * * * It also appears that the plaintiff's paper has been published weekly under that name for many years in this city, that its circulation is large and valuable, and that it was the only Police Gazette, *co nomine*, published in the United States at the time of the publication of the paper complained of by them, and the only one published in this city. That the exception mentioned was of a Police Gazette of local circulation, published in California. *From these facts it is apparent that the plaintiffs have acquired a right connected with the publication of a paper called the National Police Gazette, which must be preserved against any fraud attempted to be perpetrated against them.*"

The note of Mr. Rowland Cox, the famous trade-mark lawyer and writer upon that branch of the law, on the case of *Clemens v. Belford*, 14 Fed., 728 (Cox's "Manual of Trade-Mark Cases", 2d ed., pages 431, 432), in part reads as follows:

"The names of periodicals and newspapers, as distinguished from books, are protected as in the nature of trade-marks; and in many instances the

publications in connection with which the names have been used were proper subjects of copyright. In some cases they contained, or might have contained, articles in connection with which the statutory privilege [of copyright] had been acquired. But the name which has been protected has never been simply the name of a book, but always that of a constantly changing series. Thus the term 'Old Slenth Library' was distinctly arbitrary, and never the name of a particular book or literary production; and for this reason it was in an accurate sense a trade-mark, and must continue to be as long as the publication was continued."

The stories in the weekly issues of petitioners' (complainants') weekly periodical are not entitled "Nick Carter". Complainants' Exhibit E is entitled "The Red Button; Or, Nick Carter's Quest for a Plotter". The trade-mark on the weekly in which that story appears is at the top of the title page, and reads as follows: "New NICK CARTER Weekly". Petitioners (complainants) are not, as claimed by respondents (defendants), trying to substitute a trade-mark or the principles of unfair competition in business for a copyright. Their copyright is in the work entitled "The Red Button; Or, Nick Carter's Quest for a Plotter"; but their trade-mark "NICK CARTER" is for "a weekly periodical devoted to fiction"; and they claim that, as the kind of fiction to which it is devoted is detective stories, and as the kind of story that respondents (defendants) have associated with the name "Nick Carter" is a detective story, they are injured thereby, and will be injured by continued infringement, and that this is true whether a detective story put upon a motion picture film is regarded by the court as belonging to the same class of goods as such

stories printed in periodical form, and thereby an invasion of a technical trade-mark, or whether the court can see and decides that such use of the name "NICK CARTER" by respondents (defendants) amounts to an attempt unfairly to trade upon the reputation of petitioners (complainants).

Mr. Cox's reference in the foregoing language quoted from him to the words "Old Sleuth Library" undoubtedly is to the case of *Monro v. Tousey*, in the Court of Appeals of New York, 129 N. Y., 38, 14 L. R. A., 245, in which that court said:

"That the plaintiff would be entitled to the protection of the law against the use by others of the words 'Old Sleuth Library', as used to describe a series of publications, or against the use of the name, 'Old Sleuth, the Detective,' for a work of fiction, may be conceded. That is plainly right, and, in order to afford protection more adequate than would be afforded by an action at law, the equity power of the courts might be successfully invoked to restrain a similar use by others of such names, and to prevent a species of literary piracy. This power is exerted upon the same principle upon which the court acts in trade-mark cases in restraining the unauthorized use of the label or sign constituting the trade-mark. The theory upon which the court of equity has long acted is that a resemblance in, or an imitation of, the names, signs, or marks, under which another conducts a business, is a deception practiced upon the public, and an injury to the proprietor in the loss of custom and patronage, to redress which an action at law for damages is not a sufficiently satisfactory remedy. That is the principle we may extract from the often-cited opinions of Lord Eldon in *Hogg v. Kirby*, (1803) 8 Ves., 215, of Lord

Langdale in *Knott v. Morgan*, (1836) 2 Keen, 213, and of our own chancellors in the early cases of *Snowden v. Noah*, (1825) Hopk. Ch., (N. Y.) 347, and of *Bell v. Locke*, (1840) 8 Paige, (N. Y.) 75. A publication is the subject of property, and there is no reason why, like every other kind of property, it should not be the subject of the law's protection. To put out a colorable imitation of it, by which the public may be easily misled into supposing that it is the literary article they had in mind to obtain and read, is an act of deception which injures the publisher."

Mr. Rowland Cox, in his note to the case of *Jollie v. Jacques* (Cox's Manual of Trade-Mark Cases, 2d Ed., pp. 57, 58, note 3 to case No. 105), says:

"There would be a species of fraud in an American reprint of '*Ivanhoe*' under the title of '*The Knight of the Black Plume*', and yet no remedy of any sort. But to publish the story of '*Uncle Tom's Cabin*' under the title of '*Aunt Chloe's Home*' would be an invasion of the copyright law; while to print another novel under the name of '*Uncle Tom's Cabin*' would be an injury involving a remedy of an entirely different nature. In the instance last mentioned there would be no violation of the copyright, but an infraction, to all intents and purposes, of a trade-mark. * * * The sale of another book under the name of one which no other person has the right to sell is a misrepresentation, accompanied by a loss of sales, and an actionable injury under the principles which govern the law of trade-marks. * * * But it is quite apparent that, in order to be susceptible of protection, the title of a book must be distinctive, and not descriptive. That is, it must be original in itself, or in its application, and not a

mere statement of a fact that would be equally true of other and different books. To illustrate: 'The Life of Thackeray' could not be monopolized, as it is a mere statement of a fact that is essentially *publici juris*; but 'Evenings with Thackeray' would be of a different nature, and analogous to a trade-mark, the words being invested with a secondary meaning, having relation to a particular volume, and which would be untrue in their application to any other."

In the case of Hopkins Amusement Co. v. Frohman, 202 Ill., 541, 67 N. E., 391, the Supreme Court of Illinois affirmed a decree for an injunction (103 Ill. App. 613) in a case where the plaintiff was the producer of the play "Sherlock Holmes, Detective", basing the plaintiff's right to equitable relief upon the ground that the names of the respective plays were so similar that the public "would be deceived to the belief that the drama of the appellant company was that which the appellee had been producing". The court further said:

"Equity provides a remedy to prevent such unfair and fraudulent competition among business rivals in any and all lines of legitimate trade and business."

On this case, Nims on "Unfair Business Competition" comments, at page 83, as follows:

"As between rival claimants to the right to reproduce a drama or play, while the author and he to whom it was sold were entitled to protection, it was held that the public were entitled to be honestly informed as to who was playing it, that they might not confuse the play in question with a poor imitation. (Hopkins Amusement Co. v.

Frohman, 103 Ill. App., 613-1902.) Frohman and Gillette put on the stage a play called 'Sherlock Holmes'. Appellant attempted to play a piece called 'Sherlock Holmes, Detective'. Held, names of publications may be protected by trade-mark (citing *Robertson v. Berry*, 50 Md., 591-1878). 'Sherlock Holmes', the drama, has not been copyrighted. Its authors and Frohman as their grantee have right to protection on the ground of their property in it (citing *McLean v. Fleming*, 96 U. S., 245-1877; 24 L. Ed., 828). Frohman owned exclusive right to produce this play by contract with the author. One seeing advertisement of 'Sherlock Holmes, Detective,' would suppose it the same as Frohman's play. The public are entitled to protection as well as Frohman. Honest competition relies upon the intrinsic merits of the goods. It does not require a false or fraudulent mark. To give to the product of what is claimed to be superior skill, the name, similitude and imitation of an article with which it professes to compete is fraud. The public should not be obliged to guard against such methods."

The United States Patent Office has been authorized by statute (Act of May 4, 1906) to divide the different kinds of goods for which trade marks applied thereto may be registered, and has established fifty such classes, No. 38 of which is "Prints and Publications" (according to the classification as revised to November 1, 1911, contained in Patent Office pamphlet bearing imprint "Revised November 1, 1911", and first published 130 O. G., 1944, and changes thereto published in 140 O. G., 259).

Deciding the case of *Estes v. Williams*, 21 Fed., 191, Judge Wheeler expressed himself as follows:

“Mr. James Johnston, of London, England, appears to have published a regular series of juvenile books of uniform appearance, and in a style of peculiar attractiveness, and called them the Chatterbox, until they have become widely known and quite popular by that name, in that country and this. * * * There being no copyright to prevent, the defendants claim the right to so print and publish the series of books in this country, and that if they have not the right, the orators have no right to prevent them. There is no question but the defendants have the right to reprint the compositions and illustrations contained in these books, including the titles of the several pieces and pictures. *Jollie v. Jacques*, 1 Blatchf., 618. That does not settle the question as to the right claimed here. There is work in these publications aside from the ideas and conceptions. Johnston was not the writer of the articles nor the designer of the pictures composing the books, but he brought them out in this form. The name indicates this work. The defendant, by putting this name to their work in bringing out the same style of book, indicates that their work is his. This renders his work less remunerative, and while continued is a continuing injury which it is the peculiar province of a court of equity to prevent. These principles are discussed, settled, and applied in *McLean v. Fleming*, 96 U. S., 245. * * * Johnston had the exclusive right to put his own work as his own, upon the markets of the world. No one else had the right to represent that other work was his. Not the right to prevent the copying of his, and putting the work upon the markets, but the right to be free from untrue representations that this other work was his when put upon the markets. This gives him nothing but the fair enjoyment of the just reputation of his

own work, which fully belongs to him. It deprives others of nothing that belongs to them."

In the case of *Estes v. Leslie*, 27 Fed., 22, 23, Judge Wheeler said:

"Whether the use which the defendants make of the name is calculated to put their publications in the place which those of the orators would otherwise take is principally a question of fact, and is the most important one open in this case. The publications of Johnston were composed of selections of stories, sketches and poems, with pictorial illustrations intended for, and interesting to, the young; printed with a headline 'Chatter-box', on each page; bound in square form, in illuminated boards, with vignette slightly varying in style from one number to another, and the name 'Chatterbox' prominently on the front, and with a plain cloth back. The selections had been made with such care and skill, and the illustrations and the style of binding made so attractive that they had acquired great popularity, and found large sales, as well in this country as elsewhere. The same method of selection and illustration, square form, style of binding, and of vignette, as well as the name on cover, have been taken by the defendants. The name is the only thing in question in this case, but the adoption of so many other features tends to show the intent with which the name has been used. All of these things together lead plainly to the conclusion that the name has been appropriated to gain an advantage from the reputation and popularity which Johnston's work had acquired under it, and that this appropriation of it is calculated to make the works of the defendants pass for his to some extent. It is true that the name 'Frank Leslie' is added, so that the

title is 'Frank Leslie's Chatterbox', and the address of the publishing house is put on. This appears to be done, however, for adding the reputation of Frank Leslie and that of the publishing house to that of the Chatterbox, rather than for that of building up a new reputation under that name. If nothing had been wanted of the popularity which had been acquired under it, and which it stood for, it could have been left, and another name taken to build up."

In the case of *Estes v. Worthington*, 31 Fed., 154, 155, the language of Judge Shipman is as follows:

"This is a bill in equity, to restrain the defendant from the infringing use of the plaintiff's title, 'Chatterbox'; the said word being alleged to be a well known trade-mark of the plaintiffs' as assignees of James Johnston, and designating a well-known series of books, of a juvenile character, which are compiled by the said Johnston, and are published in this country by the plaintiffs, and it being alleged that the defendant has imprinted the same trade mark upon his juvenile publications of substantially the same class, style, and character as those made and issued by said Johnston and the plaintiffs. The most important facts in the case are stated in the opinions of this court in the similar case of *Estes v. Williams*, 21 Fed. Rep., 189, and *Estes v. Leslie*, 27 Fed. Rep., 23. * * * Johnston was the originator, in the year 1866, of the title 'Chatterbox' upon a continuous, annual series of books which he caused to be compiled, containing illustrations and stories of a class and style adapted to young persons. His series called 'Chatterbox' has become widely known and very popular in England and in this country, and his 'Chatterbox' books have had a distinctive title or

name, appearance, style, and manner of cover and printing, which caused them to be universally recognized as the books which had attained and maintained a well-known and highly-appreciated character. * * * By association, this title, when used upon juvenile books of illustrations and stories, pointed 'distinctively to the origin or ownership' of the books to which it was applied, and the name has acquired 'an understood reference' to the English series, whose character has become widely known. *Canal Co. v. Clark*, 13 Wall. 311; *Manufacturing Co. v. Trainer*, 101 U. S. 51."

In the case of *Kipling v. G. P. Putnam's Sons*, 120 Fed., 631, 635, the U. S. Circuit Court of Appeals for the Second Circuit explicitly distinguished between the trade mark of a publisher (*e. g.*, on and for books) and that *alleged* (but doubted by the court to be possible) to belong to the author. Said the court in that case:

"It appeared to be the mark of the publishers and not of the author."

**RESPONDENTS' (DEFENDANTS') AND PETITIONERS' (COMPLAINANTS') PRODUCTS
BELONG TO THE SAME CLASS
OF GOODS.**

The court will naturally be guided by the analogies afforded by other trade mark and unfair competition cases in which the question has arisen as to whether or not the goods dispensed by the parties belong to the same class.

It is conceded that to sustain a charge of trade-mark infringement, which is a narrower and more technical question than whether or not a defendant has been

guilty of unfair competition in business, on which branch of the case we shall cite numerous authorities later, the owner of a trade-mark must have used it on the same class, but not necessarily on the same species, of goods as the alleged infringer (*Layton Pure Food Company v. Church & Dwight Company*, 182 Fed., 35, and authorities cited). Even, therefore, upon the relatively narrow question of whether or not petitioners are entitled to restrain as an infringement of their common law and registered trade-mark the use thereof on and in connection with moving-picture films, petitioners are entitled to prevail, because the products of both petitioners and respondents are unquestionably publications, even though they be different species of publications. Moreover, as publications, they possess the common characteristic of being detective-story fiction. The cases hereinafter cited under the title "Analogous Unfair Competition Cases" (*infra*, page 31) show that, when applied to this case, the principles of law forbidding unfair trade, which are more liberal than those applicable in determining whether or not there be infringement of a technical trade-mark, clearly entitle petitioners to the relief awarded them by the District Court and which Judge Hook's dissenting opinion in the Court of Appeals shows he deems them entitled to, but in this section of this brief we shall merely cite authorities that we think show that within the relatively technical canons of trade-mark infringement these two kinds of publications fall within the same class and that the use of petitioners' trade-mark upon respondents' publications (films) should be held as a matter of law to be likely to produce that deception of the ultimate consumer that brings the same within the same class of products as petition-

ers' and makes the same an infringement of petitioners' technical trade-mark.

Before going into the authorities, we shall briefly state the points of resemblance between respondents' product and that of petitioners.

(a) Both petitioners' and respondents' output are publications.

(b) The essential characteristic of both publications is that they are detective stories.

(c) Respondents' own advertisements call their film a "detective story" (Record, 13).

(d) The courts have recognized that moving pictures are a means of telling a story just as much as a book is:

Kalem Co. v. Harper & Bros., 222 U. S., 55, *at page* 61; 32 Sup. Ct., 20, *at page* 21; 56 L. Ed., 92, *at page* 95 (Supreme Court of the United States).

Harper & Bros. v. Kalem Co., 169 Fed., 61, *at page* 64, 94 C. C. A., 429 (C. C. A., 2d Cir.).
American Mutoscope & Biograph Co. v. Edison Mfg. Co., 137 Fed., 262, *at pages* 266 and 267 (Judge Lanning, holding U. S. Cir. Ct., Dist. N. J.).

Edison v. Lubin, 122 Fed., 240, *at pages* 240 and 241, 58 C. C. A., 604 (C. C. A., 3d Cir.).

(e) Dramatization of novels is so commonly practiced and this is so particularly true of fiction so celebrated as are the "NICK CARTER" detective stories that the public will naturally think that respondents' moving pictures are dramatizations authorized by petitioners of petitioners' "NICK CARTER" detective stories, while the fact is that they are not authorized by petitioners, and, in the instance of the particular one of respondents' films entitled "NICK CAR-

TER the Great American Detective Solves the \$100,000 Jewel Mystery", the story is not even one that has been published by petitioners, although they have published "NICK CARTER" detective stories having titles closely resembling same, such as "The Great Jewel Robbery or NICK CARTER Among the Hotel Thieves".

(f) While petitioners' detective stories are known widely as "NICK CARTER" detective stories, without regard to the fact that they are published weekly or serially, yet the weekly change of bill at theatatoriums or moving picture shows lends itself to ready adaptation by respondents and their privies to filch all of petitioners' trade based upon its weekly issue of "NICK CARTER" detective stories.

We submit this question to the court with the utmost candor, and concede the elementary proposition of law that where a trade-mark is used upon goods of a character remote from resemblance to that in connection with which the first user has acquired the right to that trade-mark there can be no infringement; as, for instance, there could be no contention (except under very special circumstances) that the use of a trade-mark on shoes infringed or unfairly competed with a trade-mark used for candy. As another instance, if petitioners' trade-mark were "NICK CARTER" for either shoes or candy, we should not claim that such trade-mark is infringed by respondents' "NICK CARTER" detective stories.

In the case of *Bass v. Feigenspan*, 96 Fed., 206, Judge Bradford held that "half and half" is the same kind of goods as pale ale, so that a maker of "half and half" who used the pale ale trade-mark on his product

would be guilty of infringement of the trade-mark of the complainant in that case for pale ale, saying:

“Courts should not be astute to recognize in favor of an infringer fine distinctions between different articles of merchandise of the same general nature, and should resolve against the wrongdoer any fair doubt whether the public may or may not be deceived through the application of the spurious symbol.”

See, also:

Gannert v. Rupert, 127 Fed., 962 (C. C. A., 2), in connection with page 224 of 119 Fed.

Warwick Tyre Co., Ltd., v. New Motor & General Rubber Co., Ltd., 27 R. P. C., 161, in the High Court of Justice, Chancery Division.

Frohman v. Morris, 123 N. Y. Supp. 1090; 35 Tr.-Mk. Rec., 33, 34 (Nov., 1910).

Enoch Morgan's Sons Company v. Ward, 152 Fed., 690, 693 (C. C. A., 7).

Omega Oil Company v. Weschler, 71 N. Y. Supp., 983, 984.

Celluloid Mfg. Company v. Read, 47 Fed., 712, 715, citing: Collins & Co. v. Ames, 18 Fed., 561; 20 Blatchf., 542; Amoskeag Mfg. Company v. Garner, 54 How. Pr., 297.

Church & Dwight Co. v. Russ, 99 Fed., 276, 279, 280.

Kathreiner's Malzkaffee Fabriken, etc., v. Pastor Kneipp Medicine Co. (C. C. A., 7), 82 Fed. 321.

In re Munch, 50 Law T. (N. S.), 12.

In re Riviere's Tr.-Mk., 32 Weekly Rep., 390.

Paine v. Caniell & Sons' Breweries, 10 R. P. C., 127.

Reymer & Bros., Inc., v. Huyler's, 190 Fed., 83.

Walter Baker & Co., Ltd., v. Harrison (C. A. D. C.), 138 O. G., 770; 32 App. D. C., 272.

Ex parte Austin, Nichols & Co., 167 O. G., 981.

- Stollwerck Bros. v. Lucerna Anglo-Swiss Milk
Chocolate Co. v. Hoffman, 171 O. G., 214.
Ex parte Crown Distilleries Co., 98 O. G., 2590.
Northwestern Knitting Company v. Garon, 128
N. W., 288 (Sup. Ct. of Minnesota).

ANALOGOUS UNFAIR COMPETITION CASES.

- Kingsley v. Jacoby, 28 Abb. N. C., 451; 20 N. Y.
Supp. 46.
Press Publishing Co. v. Levi Bros. & Co., 3 Tr.-
Mk. Rep., 59 (Feb., 1913), decided Dec. 19,
1912.
Deiz v. Lamb, 6 Robertson, 537, 538 (N. Y. Super.
Court).
Walter v. Ashton, 71 Law J. Ch., 839; 87 Law T.,
196; 51 Weedy Rep., 131; 2 Ch. L. Rep., 282.
Routh v. Webster, 10 Beav., 561.
Vanderbilt v. Mitchell, 67 Atl., 97; 14 L. R. A.,
304, 309, 310.
Thomas A. Edison v. Edison Polyform & Mfg.
Co., 73 N. J. Eq. (3 Buchanan), 136.
Atlas Assurance Co. v. Atlas Insurance Co., 112
N. W., 232, 233; 31 Tr.-Mk. Rec. (August 21,
1907), 397, 399; 138 Iowa, 228, 232.
Knott v. Morgan, 2 Keen, 213, No. 57 Cox's Man-
ual of Trade Mark Cases.
Tyaek v. Bromley, 4 Edw. Ch., 258, 275 (N. Y.
Ch. Ct.).
Enoch Morgan's Sons Company v. Wendover, 43
Fed., 420, 421, 422.
Elks v. Elks, 122 Tenn., 142, 145, 146 (Supreme
Ct. of Tenn.).
Elks v. Elks (N. Y. C. of A.), 98 N. E., 756.
Modern Woodmen of America v. Hatfield, 199
Fed., 270.
Stone v. Carlan, 2 Sandf., 738; 13 Monthly Law
Rep., 360; Cox's Manual of Trade Mark Cases,
No. 104.

- Carew v. Rutherford, 106 Mass., 1, 10, 11 (Sup. Judicial Ct. of Mass.).
- Marsh v. Billings, 7 Cush. (61 Mass.), 322; 54 Am. Dec., 723.
- Goodwin v. Hamilton, 6 Pa. Dist. R., 705.
- Howard v. Henriques, 3 Sandf., 725, 726, 728.
- Colton v. Thomas, 2 Brewst. (Pa.), 308, 310, 311.
- The Glen and Hall Mfg. Company v. Hall, 61 N. Y., 226, 232, 233.
- Pavesich v. New England Life Insurance Co., 122 Ga., 190, 207; 69 L. R. A., 101, 109.
- Sir Morell McKenzie v. Mineral Springs Company, 18 N. Y. Supp., 240.
- Prince Albert v. Strange, 2 De G. & Sm., 652.
- R. Heinisch's Sons Company v. Boker, 86 Fed., 765, 768.
- Fonotipia, Ltd., v. Bradley, 171 Fed., 951, 960, *et seq.*
- Simmons Hardware Company v. Waibel, 11 L. R. A., 267.
- Cigar Makers' Union No. 1 v. Link, quoted in 29 L. R. A., 203.
- Strasser v. Moonelis, 55 N. Y. Super. Ct., 197.
- Schmalz v. Wooley, 57 N. J. Eq., 303.
- Hetterman v. Powers, 102 Ky., 132, 138-140.
- Binns v. Vitagraph Co. of America, 132 N. Y. Supplement, 237.
- Hilson Company v. Foster, 80 Fed., 896.
- Dennison Mfg. Company v. Thomas Mfg. Company, 94 Fed., 651, 659.
- National Biscuit Company v. Swick, 121 Fed., 1007, 1010.
- R. W. Rogers Company v. William Rogers Mfg. Company, 17 C. C. A., 576, 578.
- Merriam v. Famous Shoe & Clothing Company, 47 Fed., 411, 414.
- Merriam v. Texas Siftings Pub. Co., 49 Fed., 944.

Thomas G. Plant Company v. May Company, 100
Fed., 72, 76.

**ABSENCE OF PRECEDENT IS NO BAR TO
RELIEF.**

Nashville, C. & St. L. Railway Company v. Mc-
Connell, 82 Fed., 65, 72.

Tuttle v. Buck, 119 N. W., 946, 947.

Vanderbilt v. Mitchell, 67 Atl., 97; 14 L. R. A.,
304, 310, 311.

Respectfully submitted,

HUGH K. WAGNER,

Solicitor for Petitioners.

HUGH K. WAGNER,

LEONARD J. LANGBEIN,

Of Counsel for Petitioners.

St. Louis, Missouri, June, 1913.



IN THE
SUPREME COURT OF THE UNITED STATES.

No. 618.

OCTOBER TERM, 1913.

Office Supreme Court, U. S.
FILED
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JAMES D. MAHER
CLERK

STREET & SMITH, a Copartnership
Composed of ORMOND G. SMITH,
GEORGE C. SMITH, and CORA E.
GOULD,

APPELLANTS,

vs.

THE ATLAS MANUFACTURING COM-
PANY and ORLIN T. CRAWFORD,
APPELLEES.

In Equity.

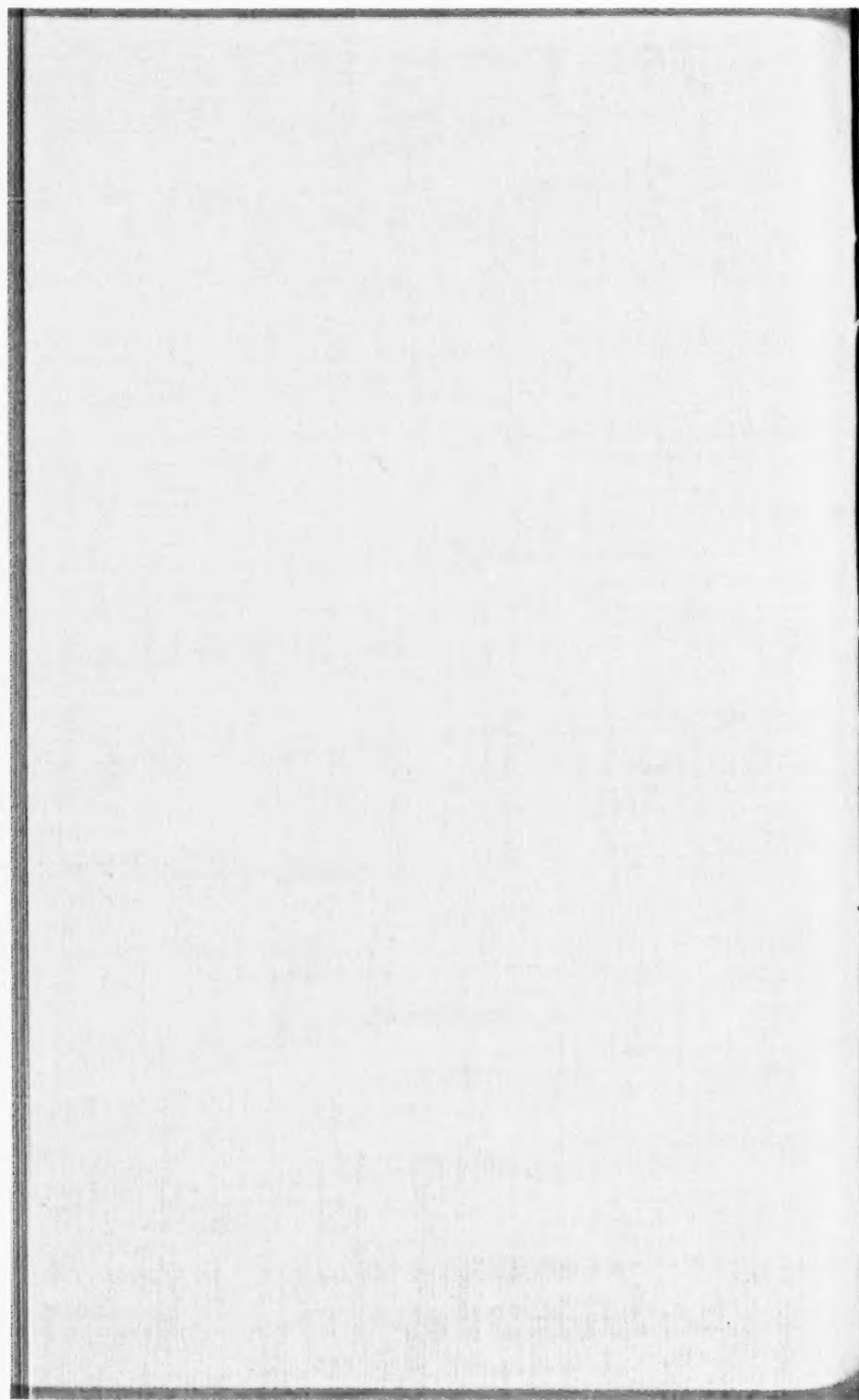
BRIEF FOR APPELLANTS IN OPPOSITION TO
APPELLEES' MOTION TO DISMISS
THE APPEAL.

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LEONARD J. LANGBEIN,
OF COUNSEL FOR APPELLANTS.



IN THE
SUPREME COURT OF THE UNITED STATES.

No. 618.

OCTOBER TERM, 1913.

STREET & SMITH, a Copartnership
Composed of ORMOND G. SMITH,
GEORGE C. SMITH, and CORA E.
GOULD,

APPELLANTS,

VS.

THE ATLAS MANUFACTURING COM-
PANY and ORLIN T. CRAWFORD,

APPELLEES.

In Equity,

BRIEF FOR APPELLANTS IN OPPOSITION TO
APPELLEES' MOTION TO DISMISS
THE APPEAL.

This appeal to this court is from a final decree dismissing the bill of complaint and was allowed by Mr. Justice Van Devanter in view of sections 128 and 241 of "The Judicial Code", which was enacted March 3, 1911 --upward of a year later than the decision of this court in *Hutchinson, Pierce, & Company v. Loewy*, 217 U. S., 457; 54 L. Ed., 838. A petition in due form for the is-

— 2 —
surance of a writ of *certiorari* has been regularly filed in this court and will be submitted at the same time as this motion, and, if the said writ of *certiorari* be granted, it will be unnecessary to decide the question of the jurisdiction of this court raised by this motion, although appellants think that the jurisdiction of this court is unquestionable and that it will save similar motions in other cases if this court holds in deciding this motion that an appeal lies to this court in cases involving **registered trade marks**.

A registered trade mark (Rec., page 11) is one of the grounds of jurisdiction of the lower court, and the new "Judicial Code" does not make such cases final in the Circuit Courts of Appeals (section 128). Cases based on registered trade marks are, of course, not cases arising "under the copyright laws", and "The Judicial Code" is the latest expression of the intention of Congress as to the cases in which the decisions of the several Circuit Courts of Appeals shall be final, and, therefore, supersedes the decision of this court in *Hutchinson v. Loewy*, *supra*, based upon this court's interpretation of prior legislative enactments. The Act of March 3, 1891, made the decisions of the Circuit Courts of Appeals final in patent cases. "The Judicial Code" adds copyright cases to the list of those that shall be final in the Circuit Courts of Appeals, but does not mention registered trade mark cases. Following, as the enactment of "The Judicial

Code" does, the decision of this court in *Hutchinson v. Loewy*, *supra*, there is a clear implication that registered trade mark cases are not final in the Circuit Courts of Appeals.

"The Judicial Code" is the latest *fiat* of the Congress as to the jurisdiction of the several courts of the United States. Those courts have no jurisdiction except such as is expressly conferred upon them by statute, and, as "The Judicial Code" is a comprehensive statute changing the jurisdiction of the several courts of the United States from that previously existing, it can not be interpreted or construed otherwise than as an Act of Congress explicitly and completely **defining** the jurisdiction of the Federal courts of different kinds and grades from and after the date of its going into effect and until changed by subsequent statutes. For this reason, any decision of this court that it did not have jurisdiction of a certain class of cases prior to the going into effect of "The Judicial Code" is not in the slightest degree an authority or precedent, analogically or otherwise, that this court has not jurisdiction of that class of cases brought to it later than the going into effect of "The Judicial Code", because the sole test at the present time of what appellate jurisdiction this court possesses is the language of "The Judicial Code".

The jurisdictional clauses of the Act of Congress approved February 20, 1905 (33 Stat. at L., 728, Chap.

592; U. S. Comp. St. Supp., 1907, page 1283), are expressly repealed by the last paragraph of section 297 of "The Judicial Code", because "embraced within" the provisions as to the jurisdiction of the courts contained in "The Judicial Code".

That the Congress, when enacting "The Judicial Code", understood the difference between trade-marks and copyrights is manifest from the fact that in subsection 7 of section 24, Chap. 2, thereof (which prescribes the jurisdiction of the District Courts) it confers jurisdiction upon the District Courts of "All suits at law or in equity arising under the patent, the copyright, and the trade-mark laws." Not only does this provision of "The Judicial Code" distinctly show that the Congress recognized when enacting the same the difference between the trade-mark laws of the United States and the copyright laws, but it, also, shows that "The Judicial Code" supersedes the jurisdictional parts of the trade-mark statute of February 20, 1905.

What, then, do we find to be the provisions of "The Judicial Code" with respect to appeals from the decisions of the District Courts of the United States in cases involving trade-marks **registered** under the laws of the United States?

Section 128 of "The Judicial Code" answers this question as follows:

"The judgments and decrees of the Circuit Courts of Appeals shall be final * * * in all

cases arising under the patent laws, under the copyright laws, under the revenue laws, and under the criminal laws, and in admiralty cases."

Section 241 of "The Judicial Code" supplements this answer as follows:

"In any case in which the judgment or decree of the Circuit Court of Appeals is not made final by the provisions of this Title, there shall be of right an appeal or writ of error to the Supreme Court of the United States where the matter in controversy shall exceed one thousand dollars, besides costs."

The Act of March 3, 1891, Ch. 517, 26 Stat. at L., 826, 4 Fed. Stat. Anno., 409, creating the United States Circuit Courts of Appeals, provided:

"* * * The judgments or decrees of the Circuit Court of Appeals shall be final * * * in all cases arising under the patent laws, under the revenue laws, and under the criminal laws and in admiralty cases."

That the omission in "The Judicial Code" to make cases arising under the trade-mark registration statute final in the United States Circuit Courts of Appeals was not accidental, but intentional, is shown by the fact that the foregoing clause of the said Act of March 3, 1891, is re-enacted in "The Judicial Code" in the identical language of the 1891 statute with the ex-

ception of the insertion therein of the additional class of cases, *viz.*, those arising "under the copyright laws."

Even if this were not so, it has been held by this court in *Hobbs v. McLean*, 117 U. S., 567, 6 Sup. Ct. Rep. 870, 29 L. Ed., 940, that where a provision is left out of a statute either by design or mistake of the legislature, the courts have no power to supply it, as to do so would be to legislate and not to construe.

In delivering the opinion of the Supreme Court of the United States in the case of *United States v. Goldenberg*, 168 U. S., 95, 102, 103, 18 Sup. Ct. Rep., 3, 42 L. Ed., 394, 398, Mr. Justice Brewer said:

"The primary and general rule of statutory construction is that the intent of the lawmaker is to be found in the language he has used. He is presumed to know the meaning of words and the rules of grammar. The courts have no function of legislation, and simply seek to ascertain the will of the legislator."

No mere omission or failure to provide for contingencies will justify judicial addition to a statute.

Glover v. United States, 164 U. S., 295; 41 L. Ed., 440; 17 Sup. Ct. Rep., 95.

McKee v. United States, 164 U. S., 287; 41 L. Ed., 437; 17 Sup. Ct. Rep., 92.

United States v. Goldenberg, 168 U. S., 103; 42 L. Ed., 398; 17 Sup. Ct. Rep., 3.

In the case of *Beechwood v. Joplin-Pittsburg Rail-*

way Company, 158 S. W., 868, 871. Judge Sturgis, speaking for the Springfield Court of Appeals, used the following language:

"The law, like the clouds, has a silver lining, and the remedial statutes are intended to put the silver lining on the outside. So in *Stid v. Railroad*, 211 Mo., 411, 418, 109 S. W., 663, the court points out the proper attitude for courts to assume with reference to statutes giving the right to appeal, as follows: 'An appeal being the creature of the statute, the object to be subserved being to get at the very right of the cause, statutes pertaining to procedure are entitled to a liberal construction, and courts should not be prone to plant thorns in the path of appeal.' "

Appellants think it clear that the motion of the appellees to dismiss this appeal and to affirm the decision of the lower court should be overruled.

Respectfully submitted,

HUGH K. WAGNER,

Solicitor for Appellants.

HUGH K. WAGNER,

LEONARD J. LANGBEIN,

Of Counsel for Appellants.

St. Louis, Missouri, November 3, 1913.



John S. Smith, Esq.,
1112-1113

1913

JOHN S. SMITH
D.E.

IN THE

OFFICE OF THE UNITED STATES

DEPARTMENT OF THE INTERIOR

GEORGE C. SMITH & Co.

Applicant

vs.

THE ATLANTIC MANUFACTURING
COMPANY & Co.

No. 270

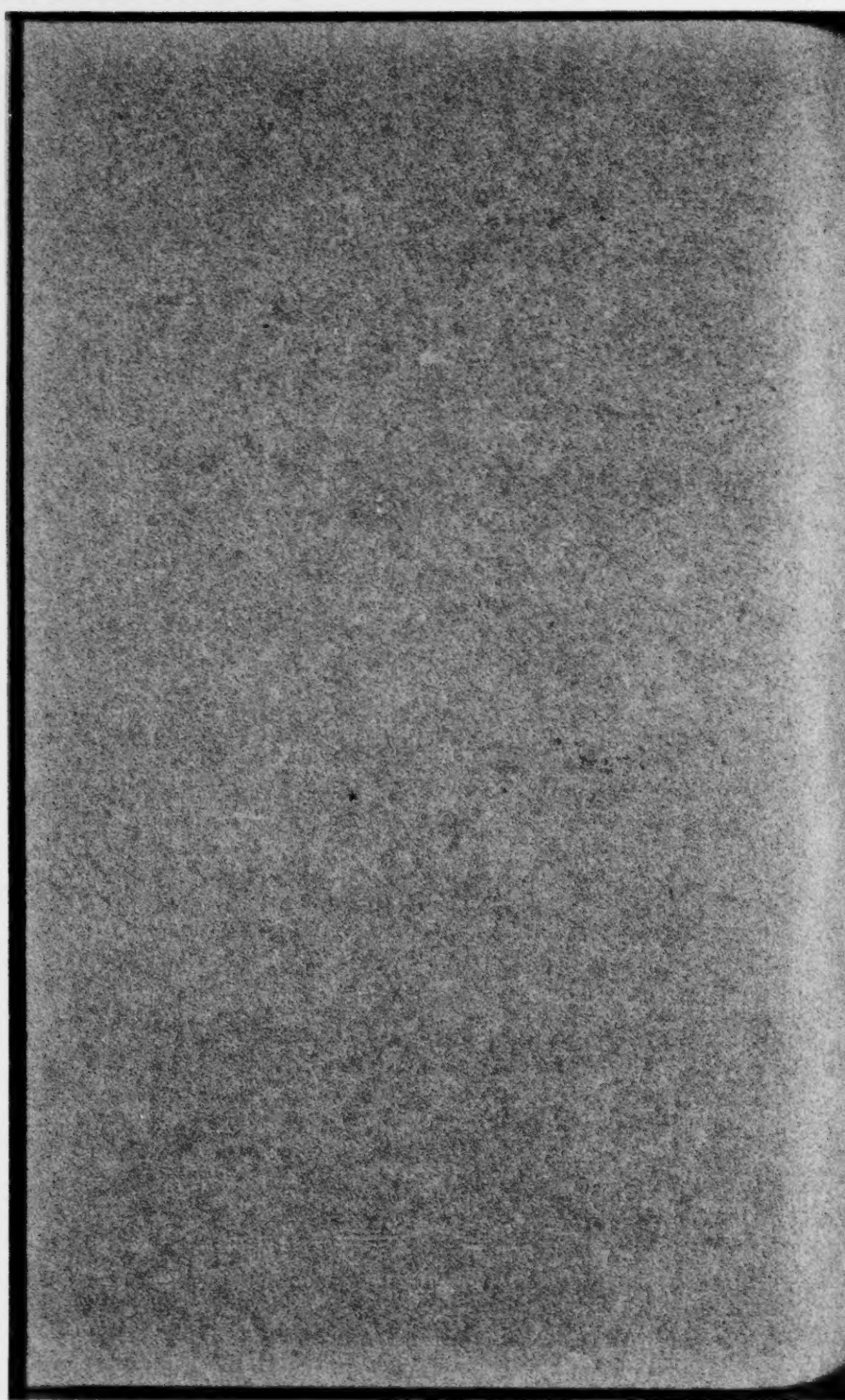
Applicant

— APPEAL FROM THE DECISION OF THE
SPECIAL AGENT IN CHARGE OF THE LAND OFFICE

WILLIAM T. SMITH
JAMES LOVE SMITH

Attorneys and Counsel for Applicant

— APPEAL FROM THE DECISION OF THE
SPECIAL AGENT IN CHARGE OF THE LAND OFFICE



IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1913.

ORMOND G. SMITH *et al.*,

Appellants.

vs.

THE ATLAS MANUFACTURING
COMPANY *et al.*,

Appellees.

No. 618.

MOTION TO DISMISS AND AFFIRM.

Now this day come The Atlas Manufacturing Company and Orlin T. Crawford, Appellees, and move to dismiss the appeal herein, and that the judgment of the court below be affirmed, for the following reasons:

**STATEMENT OF THE FACTS AND OBJECT OF
THE MOTION.**

Complainants brought this action in the District Court of the United States for the Eastern District of Missouri, alleging trademark infringement. Federal jurisdiction was based on two grounds: first, diverse citizenship, and, second, that complainants' trademark under the act of Feb. 20, 1905, was being infringed by defendants.

Upon application of complainants, the District Court entered an order of preliminary injunction and defend-

ants appealed from said order, the appeal being heard in United States Circuit Court of Appeals for the Eighth Circuit, which Court on March 26, 1913, handed down its decision reversing the decree of the District Court and remanding the case with directions that the preliminary injunction be dissolved and the complainants' bill be dismissed for want of equity. (The opinion of the United States Circuit Court of Appeals is found in 204 Fed. Rep., p. 398, and here at Record, p. 47.) Thereafter an appeal was taken to this Court.

Wherefore appellees move that the appeal herein be dismissed and that the judgment of the Circuit Court of Appeals for the Eighth Circuit be affirmed at the costs of the appellants, upon authority of *Hutchinson, Pierce & Co. vs. Loewy*, 217 U. S. 457-460.

NELSON THOMAS,

JAMES LOVE HOPKINS,

Solicitors and Counsel for Appellees.

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1913.

ORMOND G. SMITH *et al.*,

Appellants.

vs.

THE ATLAS MANUFACTURING
COMPANY *et al.*,

Appellees.

No. 618.

**BRIEF OF APPELLEES ON MOTION TO DIS-
MISS APPEAL AND TO AFFIRM.**

I.

This case is one of trademark infringement based upon Certificate No. 77,581, registered April 19, 1910, under the Act of February 20, 1905, 33 Stat. at L. 728, Chap. 592.

As to trademarks registered under the Act of 1905, the jurisdiction of the Circuit Courts of Appeals is final.

In *Hutchinson, Pierce & Co. vs. Loewy*, 217 U. S. 457, 460, 54 L. Ed. 839, Mr. Chief Justice Fuller said:—

“Sections 17 and 18 of the Act of Congress approved February 20, 1905, in respect to trademarks, read as follows:

‘Section 17. That the circuit and territorial courts of the United States and the Supreme Court

ants appealed from said order, the appeal being heard in United States Circuit Court of Appeals for the Eighth Circuit, which Court on March 26, 1913, handed down its decision reversing the decree of the District Court and remanding the case with directions that the preliminary injunction be dissolved and the complainants' bill be dismissed for want of equity. (The opinion of the United States Circuit Court of Appeals is found in 204 Fed. Rep., p. 398, and here at Record, p. 47.) Thereafter an appeal was taken to this Court.

Wherefore appellees move that the appeal herein be dismissed and that the judgment of the Circuit Court of Appeals for the Eighth Circuit be affirmed at the costs of the appellants, upon authority of *Hutchinson, Pierce & Co. vs. Loewy*, 217 U. S. 457-460.

NELSON THOMAS,

JAMES LOVE HOPKINS,

Solicitors and Counsel for Appellees.

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1913.

ORMOND G. SMITH <i>et al.</i> ,	Appellants.	} No. 618.
vs.		
THE ATLAS MANUFACTURING COMPANY <i>et al.</i> ,	Appellees.	

**BRIEF OF APPELLEES ON MOTION TO DIS-
MISS APPEAL AND TO AFFIRM.**

I.

This case is one of trademark infringement based upon Certificate No. 77,581, registered April 19, 1910, under the Act of February 20, 1905, 33 Stat. at L. 728, Chap. 592.

As to trademarks registered under the Act of 1905, the jurisdiction of the Circuit Courts of Appeals is final.

In *Hutchinson, Pierce & Co. vs. Loewy*, 217 U. S. 457, 460, 54 L. Ed. 839, Mr. Chief Justice Fuller said:—

"Sections 17 and 18 of the Act of Congress approved February 20, 1905, in respect to trademarks, read as follows:

'Section 17. That the circuit and territorial courts of the United States and the Supreme Court

of the District of Columbia shall have original jurisdiction, and the Circuit Courts of Appeal of the United States and the Court of Appeals of the District of Columbia shall have appellate jurisdiction, of all suits at law or in equity respecting trademarks registered in accordance with the provisions of this Act, arising under the present Act, without regard to the amount in controversy.'

'Section 18. That writs of *certiorari* may be granted by the Supreme Court of the United States for the review of cases arising under this Act in the same manner as provided for patent cases by the Act creating the Circuit Court of Appeals.' (33 Stat. at L. 728, chap. 592, U. S. Comp. Stat. Supp. 1909, p. 1283.)

We are of opinion that this appeal will not lie, and that the remedy by *certiorari* is exclusive. By the 6th section of the Judiciary Act of March 3, 1891, the final decision of the Circuit Courts of Appeal are made final '*in all cases arising under the patent laws under the revenue laws, and under the criminal laws and in admiralty cases,*' with power in this court to require any such cases to be certified thereto for its review and determination, '*with the same power and authority in the case as if it had been carried by appeal or writ of error to the Supreme Court.*' (26 Stat. at L. 828, chap. 517, U. S. Comp. Stat. 1901, p. 549.)

We think that the language of Sec. 18 places suits brought under the Trademark Act plainly within the scope of the Act establishing the Court Appeals, and that a final decision of that court can be reviewed in this court only upon *certiorari*, and that therefore the pending appeal must be dismissed. And this conclusion is sustained by *Atkins v. Moore*, 212 U. S. 285, 291, 53 L. Ed. 515, 517; 29 Sup. Ct. Rep. 390 "

II.

As to the charge of unfair competition the jurisdiction depends solely upon diversity of citizenship and the decree of this court is final.

"Such an issue (*i. e.*, unfair competition) between citizens of different states, even if there were no technical trademark, a Circuit Court would have jurisdiction to try, and the Circuit Court of Appeals would have jurisdiction to review; but *the judgment of the latter court* would be final."

Mr. Justice McKenna, in *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U. S. 446, 457, 55 L. Ed. 542.

III.

Since *Hutchinson, Pierce & Co. v. Loewy*, *supra*, the Supreme Court has entertained appeals, as before, in cases based on trademarks registered under the Act of March 3, 1881; but never in cases based on registrations under the Act of 1905.

See:

Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U. S. 446, in which the trademark was Certificate No. 36,485, Registered May 28, 1901, under the Act of 1881, as shown by the record of that case in this court, case No. 106, October Term, 1910.

Baglin v. Cusenier Co., 221 U. S. 580, 587, 55 L. Ed. 867, in which the two trademarks were registered in 1884 under the Act of 1881, as disclosed by the opinion.

IV.

It is stated by counsel for complainants (appellants) in their petition for *certiorari* (p. 2) that the appeal to this court was allowed by Mr. Justice Vandevanter "in view of sections 128 and 241 of the 'Judicial Code' which was enacted March 3, 1911—upward of a year later than the decision of this court in *Hutchinson, Pierce & Co. v. Loewy*, 217 U. S. 457; 54 L. Ed. 838," decided May 16, 1910.

The legislative enactments under which this Court

will determine Appellants' right to an appeal to the Supreme Court in the case at bar are substantially the same as those considered by the Court in the case of *Hutchinson, Pierce & Co. vs. Loewy, supra*. Unless this Court, speaking through the learned Chief Justice, was utterly wrong in its view of that case, complainants are not entitled to an appeal in the case at bar and the motion to dismiss the appeal should be sustained.

Counsel for complainants argue that the *Hutchinson vs. Loewy* case is "overruled by implication," because Congress in formulating the Judiciary Act of 1911, added copy-right cases to the list of those that should be final in the Circuit Courts of Appeals, but omitted to mention registered trademark cases. We submit that the implication or, rather, the inference, is to the contrary effect. When the act of 1911 was being formulated, *Hutchinson vs. Loewy* was the law. Under it and the statutes, cases relating to trademarks registered under the Act of 1905 were unquestionably not appealable from the Circuit Courts of Appeals. Leaving the governing sections of the statutes practically unchanged, Congress omits to mention trademark cases. Why should they be expressly enumerated? They were already final in the Courts of Appeals. Copyright cases had never been by this Court declared final in the Courts of Appeals, and therefore Congress, in pursuance of its obvious purpose of relieving the Supreme Court of copyright litigation, adds copyright cases in terms. The Trade-mark Act of 1905, as construed by this court in the *Hutchinson* case relieved this court of litigation under said Act, and, therefore express enumeration of trademark cases would have been superfluous.

We repeat, therefore, that the inference is in support of and not against the doctrine of the *Hutchinson* case; that that case governs, that no appeal lies in this

case, and that the appeal should therefore be dismissed and the decree appealed from affirmed.

Respectfully submitted,

NELSON THOMAS,

JAMES LOVE HOPKINS,

*Solicitors and of Counsel for Appel-
lees, The Atlas Mfg. Co., and Orlin
T. Crawford.*

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1913.

ORMOND G. SMITH *et al.*,

Appellants.

vs.

THE ATLAS MANUFACTURING
COMPANY *et al.*,

Appellees.

No. 618.

NOTICE OF MOTION TO DISMISS AND AFFIRM.

To the Appellants above named or their counsel:

Take notice, that we will on Monday, the 10th day of November, 1913, at the hour of twelve, noon, or as soon thereafter as counsel can be heard, submit to the Supreme Court of the United States a motion to dismiss your appeal and to affirm the judgment and decree of the Circuit Court of Appeals for the Eighth Circuit, a copy of which motion and brief in support thereof are herewith served upon you.

Dated at St. Louis, Missouri, this 1st day of September, 1913.

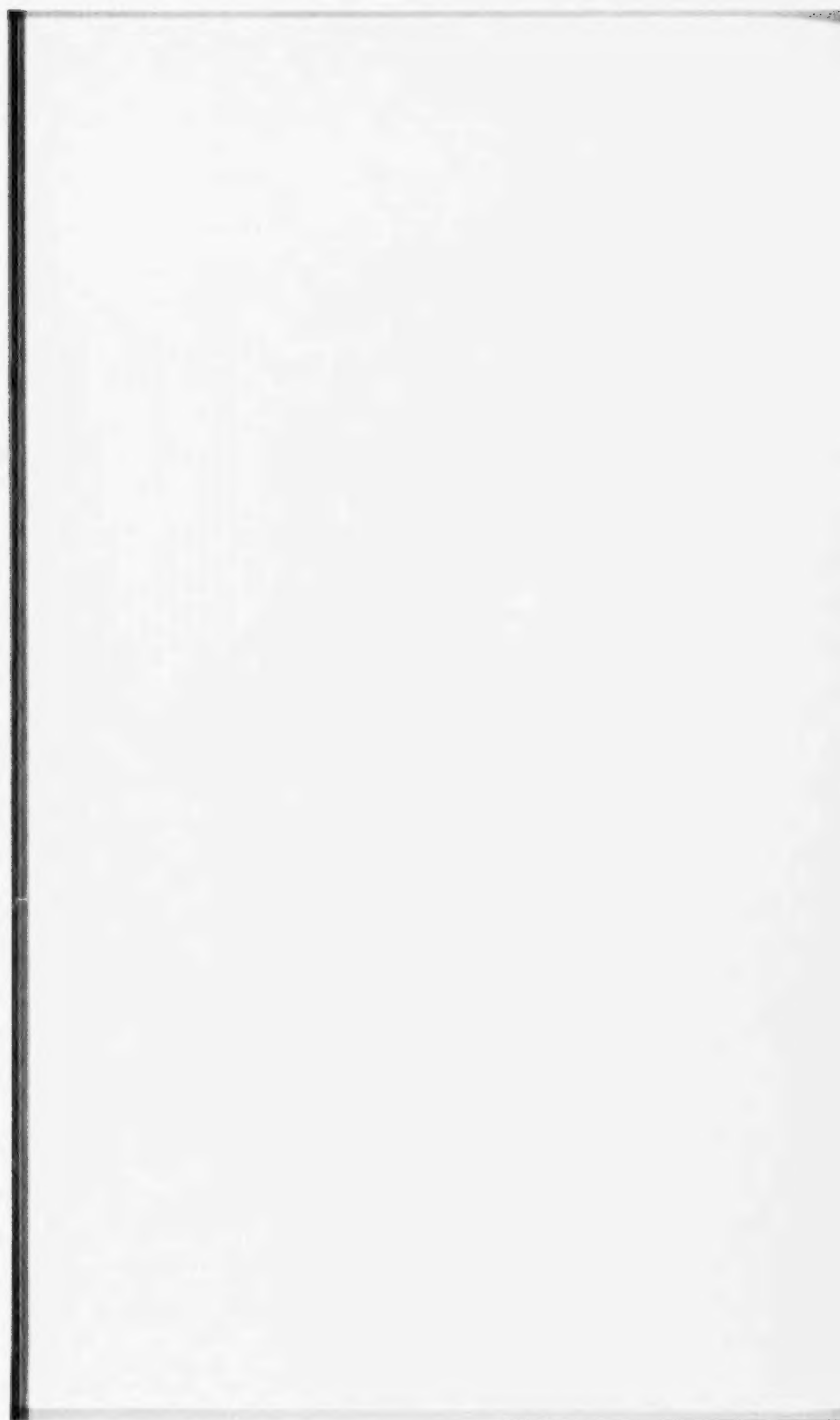
NELSON THOMAS,

JAMES LOVE HOPKINS,

Solicitors and Counsel for Appellees.

Received a copy of the foregoing notice, and said motion and brief at St. Louis, Missouri, this 1st day of September, 1913.

Solicitor and Counsel for Appellants.



IN THE
Supreme Court of the United States

No. 618.

OCTOBER TERM, 1913.

STREET & SMITH, a Copartnership,
 Composed of ORMOND G. SMITH,
 GEORGE C. SMITH, and CORA E.
 GOULD, *Petitioners,*

vs.

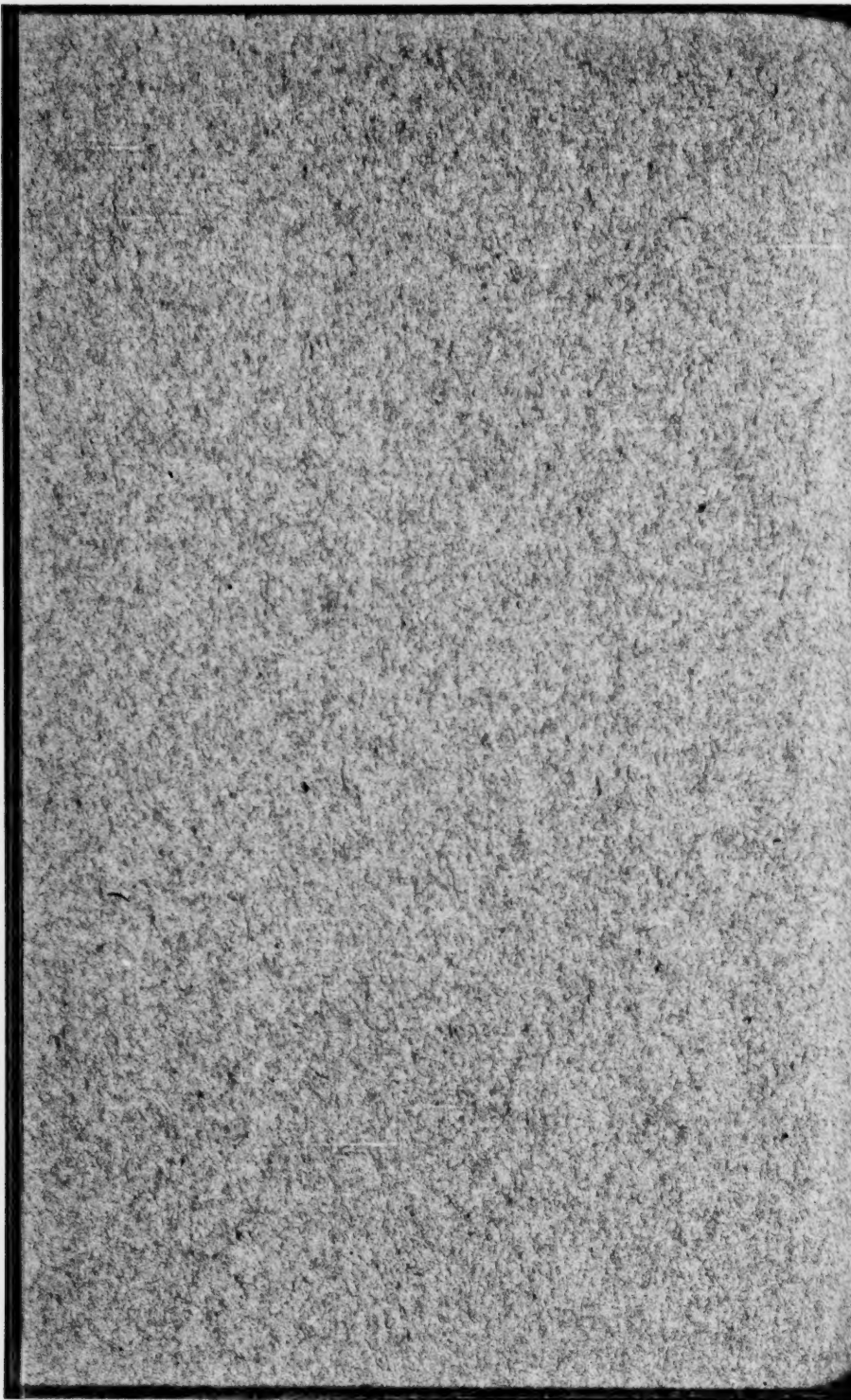
THE ATLAS MANUFACTURING
 COMPANY and ORLIN T. CRAW-
 FORD, *Respondents.*

} In Equity.

PETITION FOR CERTIORARI.

HUGH K. WAGNER,
Solicitor for Petitioners,
 Suite 503 Fullerton Building,
 St. Louis, Missouri.

HUGH K. WAGNER,
 LEONARD J. LANGBEIN,
Of Counsel for Petitioners.



IN THE
Supreme Court of the United States

No. 618.

OCTOBER TERM, 1913.

STREET & SMITH, a Copartnership, Composed of ORMOND G. SMITH, GEORGE C. SMITH, and CORA E. GOULD, <i>Petitioners</i> ,	}	In Equity.
vs. THE ATLAS MANUFACTURING COMPANY and ORLIN T. CRAW- FORD, <i>Respondents</i> .		

PETITION FOR CERTIORARI.

*To the Honorable the Chief Justice and Associate Jus-
tices of the Supreme Court of the United States:*

Now come Street & Smith, a copartnership com-
posed of Ormond G. Smith, George C. Smith, and Cora
E. Gould, the petitioners in the above-entitled cause,
and pray that this Honorable Court will issue its writ
of *certiorari* directed to the United States Circuit
Court of Appeals for the Eighth Circuit, requiring

that the record of this cause in said court and its decree be certified to this court for the determination of said cause by this Honorable Court and, thereupon, that this court will proceed to correct the errors complained of herein, by reversing said decree and giving to your petitioners such other and further relief as the nature of the case may require and as this court may deem meet and proper. For grounds of said petition, your petitioners respectfully state the following reasons:

This novel and important case has in the lower courts been presented to four judges, one of them holding the United States District Court and the other three sitting in the United States Circuit Court of Appeals. Two of these judges have decided in favor of the complainants (petitioners) and the other two in favor of the defendants (respondents). The names and dates of appointment of these four judges are as follows:

In Favor of Petitioner's Right.

Hon. William C. Hook, appointed District Judge February 13, 1899, and promoted to Circuit Judge in 1903.

Hon. Jacob Trieber, appointed July 26, 1900.

In Favor of Respondents' Fraud.

Hon. Arba S. Van Valkenburgh, appointed June 26, 1910.

Hon. Walter L. Smith, appointed January 31, 1911.

If length of judicial experience is a criterion, it would seem that the law and justice are with petitioners in this case.

The only way in which petitioners can now obtain complete justice in this matter is by the writ of certiorari of this Honorable Court.

Petitioners will litigate the question here involved in every one of the nine judicial circuits of the United States; but this mass of litigation can be made unnecessary by the grant at this time of this petition for certiorari.

The record shows the vast value of the good-will of petitioners' business in connection with its trade-mark "Nick Carter" (Record, 3, 6). The record shows (Record, 13, 14) that respondents used this name for respondents' motion-picture film because of their realization that such a use of a name so well known to the public as is "Nick Carter" in connection with detective stories would reap for respondents where they had not sown and would rapidly put into respondents' coffers money that they could not get by using a new name of their own selection or creation. This is the motive of defendants in all trade-mark and unfair competition cases.

Pithily, but completely as well as correctly, Judge Hook in his written opinion summarized this whole case in the following words (Record, 55):

"The defendants are engaged in appropriating the fruits of complainants' current endeavors, and are deceiving the public."

With the weight of judicial experience and authority in the courts below in favor of petitioners, as hereinabove shown, will this court deny petitioners a hearing?

This case is of great importance to others besides complainants. The eyes of the moving-picture world are upon this case. If this high court will take this

case, the question will be decided one way or the other, and the manufacturers and exhibitors of motion-picture films will be thereby informed as to the proper course of action in the future. If this court will not take this case by certiorari, infringements of the rights of many others besides petitioners will at once begin and multitudinous suits will follow—all of which can be prevented if this court by its writ of certiorari will take this present case and *in limine* decide authoritatively this *new legal question*, presented to the courts for the first time in the case at bar.

STREET & SMITH,

By HUGH K. WAGNER,
Solicitor for Petitioners.

HUGH K. WAGNER,

LEONARD J. LANGBEIN,

Of Counsel for Petitioners.

I hereby certify that I am of counsel for the petitioners in this cause and that in my judgment the above petition for *certiorari* is well founded in point of law and fact and ought to be granted.

HUGH K. WAGNER,

Of Counsel for Petitioners.

IN THE
Supreme Court of the United States

No. 618.

OCTOBER TERM, 1913.

STREET & SMITH, a Copartnership, Composed of ORMOND G. SMITH, GEORGE C. SMITH, and CORA E. GOULD, <i>Petitioners</i> ,	}	In Equity.
vs.		
THE ATLAS MANUFACTURING COMPANY and ORLIN T. CRAW- FORD, <i>Respondents</i> .	}	

The respondents are hereby notified that the petitioners will on Monday, the twenty-third day of February, 1914, upon their foregoing petition and upon the certified copy of the record in this cause, at the opening of the court on that date, or as soon thereafter as counsel can be heard, submit the following motion to the Supreme Court of the United States, in its court room at the Capitol, in the City of Washington, District of Columbia.

HUGH K. WAGNER,
Solicitor for Petitioners.

The foregoing notice is hereby accepted and delivery of a copy thereof and of a copy of the motion mentioned therein and of a copy of the petition for writ of certiorari therein mentioned is hereby acknowledged this 6th day of February, 1914.

JAMES L. HOPKINS,

NELSON THOMAS,

Solicitors for Respondents.

IN THE
Supreme Court of the United States

STREET & SMITH, a Copartnership,
Composed of ORMOND G. SMITH,
GEORGE C. SMITH, and CORA E.
GOULD, *Petitioners*,

vs.

THE ATLAS MANUFACTURING
COMPANY and ORLIN T. CRAW-
FORD, *Respondents*.

} In Equity.

Come now Street & Smith, a copartnership composed of Ormond G. Smith, George C. Smith, and Cora E. Gould, by Hugh K. Wagner, Esq., their counsel, and move this honorable court that it shall by certiorari or other proper process directed to the honorable the judges of the United States Circuit Court of Appeals for the Eighth Circuit require said court to certify to this court for its review and determination a certain cause in said Court of Appeals lately pending, wherein the respondents, The Atlas Manufacturing Company and Orlin T. Crawford, were appellants, and your petitioners, Street & Smith, appellees, and to that end they now tender, herewith, their petition with a certified copy of the record in said cause in said Circuit Court of Appeals.

HUGH K. WAGNER,
Counsel for Petitioners.

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